

APPLICANT(S): DESHPANDE, Nikhil et al.
SERIAL NO.: 10/608,110
FILED: June 30, 2003
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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-28 are pending in the application.

Claims 1-28 have been rejected.

CLAIM REJECTIONS

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1-28 under 35 U.S.C. § 102(e), as being anticipated by Woodward et al (US 2004/0203685). The Examiner has referred to the affidavit filed by the applicant on November 29, 2006 and alleged that the "Applicant does not account for the 18 month period of inactivity between the provided document and the decision to file, or the filing itself". Applicants respectfully traverse this rejection in view of the remarks that follow.

The critical period for establishing reasonable diligence is from just prior to the filing date of the Woodward reference, i.e. November 26, 2002, to the filing date of the present application, i.e. June 30, 2003. The evidences submitted herewith show reasonable activity during this period of seven months, the activity directly related to the reduction to practice of the present invention.

Applicant respectfully submits statements of Naomi Liver and Moshe Vegh, who were involved in the drafting of the present application.

Applicant respectfully submits Exhibits A-C. Exhibit A is a list of Attorney Activities in the EPL&C file of the present application. Exhibit B is an internal record that has been regularly kept, showing the status of Intel applications that was assigned to EPL&C. Exhibit

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C includes e-mail correspondences from April 6, 2003, June 13, 2003, June 18, 2003, June 23, 2003, June 27, 2003, June 28, 2003 and June 30, 2003.

Applicant respectfully asserts that the reasonable diligence does not require that "an inventor or his attorney ... drop all other work and concentrate on the particular invention involved...." *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986). The schedule being reflected in the submitted evidences is therefore reasonable in view of the work load of the attorneys involved in the present application. The chain of events reflected in the attached evidences is as follows:

On January 19, 2003, as shown in Exhibit A, the EPL&C patent attorney has started drafting the application, after a reasonable backlog of work which the patent attorney took in chronological order. The application has been assigned to EPL&C on October 14, 2002.

There are records of drafting work of the EPL&C patent attorney, on January 19, 2003, February 4, 2003, February 18, 2003, February 26, 2003, February 27, 2003 and March 11, 2003, which show a reasonable attorney diligence.

In Exhibit B, there is a record of March 16, 2003, showing that the 1st draft has been sent to the inventors.

On April 6, 2003, as shown in Exhibit C, the work on the application was reassigned from EPL&C to Mr. Moshe Vegh, a patent attorney of Intel Corporation, after a first draft of the application was completed by the EPL&C patent attorney.

On June 13, 2003 a marked-up version of the application has been sent by e-mail from the inventors to Moshe Vegh.

On June 18, 2003 a draft of the application has been sent by e-mail to Dekel Shiloh, an EPL&C patent attorney, for reviewing and commenting on the draft.

On June 23, 2003 instructions has been sent by e-mail to Yael Rapoport to file the application.

On June 24, 2003 declaration and assignment have been sent to the inventors by e-mail.

On June 27, 2003 declaration and assignment have been received from inventors by fax.

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On June 28, 2003 one of the inventors has been requested by e-mail to date the assignment document and re-send by fax.

On June 30, 2003 the application has been filed.

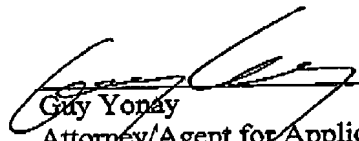
Therefore, Woodward et al cannot be cited against the present application under 35 U.S.C. § 102(e), and Applicants respectfully request that the Examiner withdraw the rejections to claims 1-28 under 35 U.S.C. § 102(e).

In view of the foregoing remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,


Guy Yonay
Attorney/Agent for Applicant(s)
Registration No. 52,388

Dated: April 16, 2007

Pearl Cohen Zedek Latzer, LLP
1500 Broadway, 12th Floor
New York, New York 10036
Tel: (646) 878-0800
Fax: (646) 878-0801

Appendix A

Exhibit A

PAGE 9/24 * RCVD AT 4/16/2007 9:36:43 AM [Eastern Daylight Time] * SVR:USPTO-EFAXRF-2/4 * DNIS:2738300 * CSID:6464175511 * DURATION (mm-ss):05-18

Exhibit B

INTEL COMMITTEE: WIRELESS COMMUNICATIONS & COMPUTING
[Ken Seddon]

EPLC Ref.	Intel Ref.	Date Given To Us	C/O	Urgency	Status	Sent abstract codes	Sent WCC Questionnaire
P-5446-US	P13195	Oct. 14, 02	MP	FILED W/O 1/2005	Revised draft		
P-5447-US	P13200	Oct. 14, 02	MP	FILED W/O 1/2005	Spoke to inventor and preparing 1st draft		
P-5441-US	P13285	Oct. 14, 02	MP	FILED W/O 1/2005	Spoke to inventor and preparing 1st draft		
P-5687-US	P16074	Feb. 9, 03			YADAV, Satyendra		
P-5756-US	P16272	Feb. 25, 03			FUDIM, Max et al.		
P-5753-US	P16271	Feb. 25, 03			GINZBURG, Boris et al.		
P-5754-US	P16270	Feb. 25, 03			LEMBERGER, Uriel et al.		
P-5753-US	P16269	Feb. 25, 03			KADAR, Oren et al.		
P-5751-US	P16267	Feb. 25, 03			GINZBURG, Boris et al.		
P-5750-US	P16266	Feb. 25, 03			SMOLYAR, Lev et al.		
P-5752-US	P16268	Feb. 25, 03			WAXMAN, Shay et al.		
P-5749-US	P16265	Feb. 25, 03			GUCHHAIT, Alanu		
P-5784-US	P16377	Oct. 14, 02		TO BE FILED BY JUNE 30, 03	RAVI, Ashoke et al.		
P-5783-US	P16376	Oct. 14, 02			RAVI, Ashoke et al.		
P-5782-US	P16375	Oct. 14, 02			RAVI, Ashoke et al.		
P-5781-US	P16374	Oct. 14, 02			RAVI, Ashoke et al.		

Exhibit C

Yael Rapoport

From: Sengupta, Uttam [uttam.sengupta@intel.com]
Sent: Sunday, June 29, 2003 7:54 PM
To: Yael Rapoport; Deshpande, Nikhil M; Knauerhase, Rob; du.v.nguyen@intel.com
Cc: Naomi Liver; Vegh, Moshe
Subject: RE: Assignment and Declaration for P15288 (our P-5450-US)

Yael,

Sorry about that oversight. However, I am unable to FAX this back next week (I am out at a conference) but will send this out week of July 7.

Thanks,
-Uttam

-----Original Message-----

From: Yael Rapoport [mailto:YaelR@eplc.co.il]
Sent: Saturday, June 28, 2003 10:36 PM
To: Deshpande, Nikhil M; Yael Rapoport; Knauerhase, Rob; du.v.nguyen@intel.com; Sengupta, Uttam
Cc: Naomi Liver; Vegh, Moshe
Subject: RE: Assignment and Declaration for P15288 (our P-5450-US)

Dear Uttam,

Please date your signature on the Assignment and refax the document to me.
Whoever witnessed your signature forgot to date it as well.

Thanks so much for all your cooperation in this matter.

Yael

Yael Rapoport
Patent Assistant
EITAN, PEARL, LATZER & COHEN-ZEDEK

- * 2 Gav Yam Center
- * 7 Shenkar Street
- * Herzlia 46725 Israel
- * Tel: +972-9-970-9022
- * Fax: +972-9-970-9001
- * E-mail: YAE LR@EPLC.CO.IL

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> -----Original Message-----

> From: Deshpande, Nikhil M [SMTP:nikhil.m.deshpande@intel.com]
 > Sent: Fri, June 27, 2003 11:19 PM
 > To: Yael Rapoport; Knauerhase, Rob; du.v.nguyen@intel.com; Sengupta,
 > Uttam
 > Cc: Naomi Liver; Vegh, Moshe
 > Subject: RE: Assignment and Declaration for P15288 (our
 > P-5450-US)

> All,
 > Assignment forms and Power of Attorney documents were signed and faxed
 > today to the EPLC Main office Fax number. I will have the originals
 > fedexed on Monday.
 > -Nikhil

> -----Original Message-----

> From: Yael Rapoport [mailto:YaelR@epic.co.il]
 > Sent: Tuesday, June 24, 2003 4:42 AM
 > To: Deshpande, Nikhil M; Knauerhase, Rob; 'du.v.nguyen@intel.com';
 > Sengupta, Uttam
 > Cc: Naomi Liver; Vegh, Moshe
 > Subject: Assignment and Declaration for P15288 (our P-5450-US)

> *****
 > Warning: Your file, ass&dec before filing.zip/P15288ver2.vsd, is
 > password-protected. It was not scanned by InterScan for SMTP.
 > *****

> Dear Nikhil, Robert, Du and Uttam,

> Attached please find a password protected ZIP file containing the
 > following:

- > 1. A copy of the application to be filed.
- > 2. A letter explaining the signing procedure. Please read the
 > letter
 > before signing.
- > 2. A copy of the Declaration and Power of Attorney. Please sign
 > and
 > date the Declaration and Power of Attorney (in blue ink) after
 > reviewing
 > the
 > final version of the application.
- > 3. A copy of an Assignment of Rights from the Inventors to INTEL
 > CORPORATION. Please sign and date the Assignment in blue ink and have
 > witnesses sign and date the Assignment and write their names and
 > addresses
 > in the space provided.
- > The Assignment and Declaration must be signed before filing the
 > application.
- > Please note, the United States Patent and Trademark Office will accord
 > a
 > filing date for the Application upon filing of the Application even
 > though
 > the Declaration is not fully executed. However, if a fully signed
 > Declaration is not submitted with the Application, the United States
 > Patent
 > and Trademark Office will issue a Notice of Missing Parts which

provides

> for

> a two month period for responding by filing the signed Declaration.

> This

> involves a surcharge fee in the amount of \$350 (which includes the

> United

> States Patent and Trademark Office fee and our Office fee).

>

> Please check that all information is correct - if not please correct

the

> documents as needed. Please have the documents properly signed, dated

> and

> witnessed where applicable. Kindly fax the documents and mail the

> originals

> to me - the fax number and address are mentioned below.

>

> Please note that in the event that we do not have the properly signed

> and

> witnessed documents when we file the application we will need to have

> the

> documents resigned by all the inventor(s) at a later date. We

apologize

> for

> this inconvenience.

>

> If you have any questions please contact Moshe Vegh or me at the
number

> below,

>

> Yael

> <<ass&dec before filing.zip>>

>

> Yael Rapoport

> Patent Assistant

> EITAN, PEARL, LATZER & COHEN-ZEDEK

>

> * 2 Gav Yam Center

> 7 Shenkar Street

> Herzlia 46725 Israel

> * Tel: +972-9-970-9022

> ? Fax: +972-9-970-9001

> * E-mail: YAEIR@EPLC.CO.IL

>

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>

Yael Rapoport

From: Vegh, Moshe [moshe.vegh@intel.com]
Sent: Monday, June 23, 2003 7:21 AM
To: YAE LR@EPLC.CO.IL
Cc: Naomi Liver (LiverN@EPLC.co.IL)
Subject: Our Ref P15288 your REF P-5450-us

Importance: High



P15288ver5.doc.ZIP



P15288ver2.vxl.ZIP

Yael,

Please file ASAP (Dekel reviewed this application).

Moshe

Yael Rapoport

From: Vegh, Moshe [moshe.vegh@intel.com]
Sent: Wednesday, June 18, 2003 3:55 PM
To: dekel@epic.us; YAE LR@EPLC.CO.IL
Subject: P15288



P15288ver1.doc.ZIP

Dekel, please review this version.

Thanks,

Moshe.

Yael please open this and send to Dekel -Moshe

Yael Rapoport

From: Vegh, Moshe [moshe.vegh@intel.com]
Sent: Saturday, June 14, 2003 7:15 PM
To: Knauerhase, Rob
Cc: Sengupta, Uttam; Deshpande, Nikhil M; Yael Rapoport
Subject: RE: P15288 comments
Importance: High

Hi,

I will ask Yael Rapoport from EPL&C to prepare the Assignment form ASAP and send them to you.

You will also be required to send us prior art documents that related to this invention:

If you are not aware of any prior art document please mention this on your reply Email.

Moshe

-----Original Message-----

From: Knauerhase, Rob
Sent: Friday, June 13, 2003 10:33 PM
To: Vegh, Moshe
Cc: Sengupta, Uttam; Deshpande, Nikhil M
Subject: P15288 comments

Moshe,

Here's our marked-up version. The inserted comments are only from me, as we worked on it in Netmeeting. We added a decision block in one of the figures, which you may want to rearrange as we just stuffed it in there. In the body, we had several minor grammar and typo corrections, but also a few bigger questions which are embedded both in Word comments and in "[[" and "]]" at the end. In the claims, we also had some questions, and it looks as though you may have repeated some of them inadvertently -- we formatted those in strikethrough for you to examine.

Please look it over and let us know what you think. We may need to get together on the phone briefly to discuss? If so, could you co-ordinate with Uttam's admin (Linda Hooper) as his schedule is busier than Nikhil's and mine.

Also, in order to make the 30-Jun deadline, could you send us the assignment forms as soon as possible (that is, before the final draft if possible), so that we can be sure to get Du Nguyen's signature on them in time for filing?

Thanks,

Rob (with Nikhil and Uttam)

<< File: P15288ver1.vsd >> << File: P15288ver11-rck.doc >>

Yael Rapoport

From: Yael Rapoport
Sent: Sunday, April 06, 2003 10:33 AM
To: Moshe Vegh (E-mail)
Cc: Naomi Liver
Subject: P-5450-US (P15288)

Moshe,

Attached please find the drawings and application for the above file. As I understand this application is now your responsibility.

Yael



5450draft.doc.jpg



drawingpt_sprint.pdf.jpg

Yael Rapoport
Patent Assistant
EITAN, PEARL, LATZER & COHEN-ZEDEK



2 Eav Yam Center
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E-mail: Rapoporty@technolawgy.com

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Appendix B

Attorney Docket No.: P-5450-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**RECEIVED
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Applicant(s): DESHPANDE, Nikhil et al. Examiner: WEST, LEWIS G
Serial No.: 10/608,110 Group Art Unit: 2618
Filed: June 30, 2003
Title: METHOD AND APPARATUS FOR FINDING AND SHARING DEVICE CAPABILITIES

STATEMENT OF NAOMI LIVER

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, the undersigned, Naomi LIVER, a citizen of Israel, do solemnly declare, as follows:

1. I am an Israeli patent attorney, working for Pearl Cohen Zedek Latzer (formerly EPL&C).
2. I hereby state that on October 14, 2002 I was assigned to draft the subject application.
3. At that time, I had a substantial workload that required most of my time, and I only reviewed the file. Accordingly, on January 19, 2003 I started working on the first draft of the subject application.
4. Considering the workload I had at that time and the urgency of some of the other work that was assigned to me, a period of 3 months (starting October 15, 2002 and ending January 19, 2003) is reasonable.
5. On March 2006 I had concluded the first draft of the subject application and sent it to the inventors. I believe that considering the extent of the workload I was faced with during that period of time, a two month period to write an application is reasonable and shows reasonable diligence to complete the application.
6. I did not complete drafting the application and I was told that it was reassigned to Mr. Moshe Vegh, an Israeli Patent attorney working for Intel Corporation.

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I, the undersigned, further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity in the above-captioned application or any patent issuing therefrom.

4/4/2007
Date

Naomi Liver
Naomi LIVER

**RECEIVED
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Attorney Docket No.: P-5450-US APR 16 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): DESHPANDE, Nikhil et al. Examiner: WEST, LEWIS G
Serial No.: 10/608,110 Group Art Unit: 2618
Filed: June 30, 2003
Title: METHOD AND APPARATUS FOR FINDING AND SHARING DEVICE CAPABILITIES

STATEMENT OF MOSHE VEGH

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, the undersigned, Moshe VEGH, a citizen of Israel, whose address Tcharfat 12th street, Natanya, Israel, do solemnly declare, as follows:

1. I am an Israeli patent attorney, employed by the Intel Corporation, in the Patent and Licencing Department.
2. I hereby state that since it was felt by the inventors that the draft prepared by EPL&C did not sufficiently capture the essence of the invention, the application was reassigned to me on April 6, 2003.
3. I further state that I then proceeded to rewrite the application, spending approximately 40 hours of work over a period of two months.
4. I believe that considering the extent of the workload I was faced with during that period of time, a two month period to rewrite an application is reasonable and shows reasonable diligence to complete the application.
5. On June 9, 2003 I forwarded the rewritten draft to the inventors who e-mailed back to me on June 13, 2003 a marked-up version of the draft.
6. On June 18, 2003 I sent a draft of the application by e-mail to Dekel Shiloh, an EPL&C patent attorney, for reviewing and commenting on the draft.

APPLICANT(S): DESHPANDE, Nikhil et al.
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7. On June 23, 2003 I issued e-mail instructions to Yael Rapoport of EPL&C to file the application.

I, the undersigned, further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity in the above-captioned application or any patent issuing therefrom.

13 March, 2007
Date


Moshe VEGH